

Remarks:

Claims 1-12 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by U.S. Patent No. 5,993,070 to Tamekuni et al. ("Tamekuni") in view of Patent No. US 6,296,398 to Lu. In view of the foregoing amendments, claims 1 and 3-12 are pending in this application. Applicants respectfully traverse.

Obviousness Rejections:

The Office Action rejects Claims 1-12 stand rejected, as allegedly rendered obvious by Tamekuni in view of Lu. In order to establish a *prima facie* case for obviousness, the Office Action must fulfill three (3) criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. In view of the foregoing amendments and the following remarks, Applicants maintain that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1 and 3-12.

Applicants are amending claims 1 and 12 to describe (1) that a fusion connection portion between the long fiber portion and the short fiber portion, which is held within the clamp portion, and (2) that the short fiber portion, which has a higher breakage resistance than the long fiber portion, is bent in a connected state of the optical connector. Applicants maintain that neither of these limitations has been shown to be disclosed or suggested by Tamekuni in view of Lu.

With respect to the first added limitation, the Office Action states that Tamekuni "does not teach fusion bonding to permanently connect the longitudinal ends of the short portion of the optical fiber and the long portion of the fiber together." Office Action, Page 2, Lines 17-18 (emphasis added); see also Office Action, Page 3, Lines 1-2 ("... despite the lack of a fully anticipatory reference"). As noted above, in order to establish a *prima facie* case of obviousness, the prior art references must disclose or suggest all the claim limitations. MPEP 2143.03. The

Office Action does not contend that Lu discloses or suggests a “fusion connection portion,” and, if Lu did disclose or suggest a “fusion connection portion,” it would still be necessary to demonstrate a suggestion or motivation to modify Tamekuni to include such a “limitation.” The Office Action further states, however, that “Tamekuni teaches that it is not necessary to bond the fibers with fusion bonding or adhesive bonding . . .” *Id.* at Lines 20-21 (emphasis added).¹ If Tamekuni does not disclose fusion bonding, but teaches that such bonding is “not necessary,” this would appear to teach away from the modification of Tamekuni to include such an unnecessary limitation. See also Office Action, Page 3, Lines 12-14. In addition, if, as the Office Action asserts, a person skilled in the art would find Tamekuni’s design “superior,” the Office Action fails to demonstrate that a person skilled in the art would be motivated to modify Tamekuni to implement a connector employing allegedly inferior, fusion bonding. Office Action, Page 2, Lines 24-25, and Page 3, Line 1.² Therefore, Applicants maintain that the Office Action fails to establish a *prima facie* case for obviousness with respect to claims 1 and 12, as amended, and respectfully requests that the Examiner withdraw the obviousness rejections of claims 1 and 12 by Tamekuni in view of Lu.

With respect to the second limitation added to claims 1 and 12, Applicants maintain that the Office Action has not yet shown that this limitation is disclosed by Tamekuni in view of Lu. Therefore, Applicants maintain that the Office Action fails to establish a *prima facie* case for obviousness with respect to claims 1 and 12, as amended, and respectfully requests that the Examiner withdraw the obviousness rejections of claims 1 and 12 by Tamekuni in view of Lu.

Applicants note that the Office Action also rejects claim 3-11, as allegedly rendered obvious by Tamekuni in view of Lu. Nevertheless, in view of the foregoing amendments and remarks, Applicants maintain that the Office Action fails to demonstrate that Tamekuni in view of Lu render claim 1, as amended, obvious. “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP

¹ See Appl’n Claims 4 and 9 (inclusion of “adhesive”).

² The mere fact that Tamekuni may be “capable” of being modified to include an allegedly, unnecessary and inferior limitation is not sufficient to establish a *prima facie* case of obviousness. MPEP 2143.01 (*citing Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)).

2143.03 (citations omitted). Therefore, in view of the foregoing amendments and remarks, the Office Action's obviousness rejections of claim 3-11 are untenable. Therefore, Applicants respectfully request that the Examiner withdraw the obviousness rejection of claim 3-11, as allegedly rendered obvious by Tamekuni in view of Lu.

Conclusion:

Applicants respectfully submit that this application, as amended, is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicants' representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Respectfully submitted,

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Enclosures